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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,332	02/09/2004	Gary T. Wang	09095.0009-01000	8910

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EXAMINER
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COPPINS, JANET L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,332	<b>Applicant(s)</b> WANG ET AL.	
	<b>Examiner</b> Janet L. Coppins	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 8,26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-25 is/are rejected.
- 7) ☒ Claim(s) 2-7,11,12,14,15,17-20 and 22-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Claims 1-27 pending in the instant application.

#### ***Information Disclosure Statement***

1. Applicant's Information Disclosure Statements, filed June 29, 2004, December 15, 2004, and January 28, 2005, have been considered by the Examiner. Please refer to the signed copies of Applicant's PTO-1449 forms submitted herewith.

#### ***Response to Amendment***

2. Receipt is acknowledged of Applicants' Preliminary Amendment, filed September 3, 2004, and Election and Response, submitted February 15, 2005, which have been reviewed by the Examiner and entered of record in the file.

3. Accordingly, claims 1-9 have been amended.

#### ***Election/Restrictions***

4. Applicant's election **with traverse** of Group I, claims 1-25, drawn to compounds of formula I, is acknowledged. The Examiner would like to direct Applicants' attention to claim 9, drawn to a method of use, which should have been included in Group II in the previous Office Action. Since Applicants have elected Group I, drawn to compounds, claim 9 is herein withdrawn from consideration, and will be added to Group II so that it may be prosecuted with the method claims. Therefore the pending compound claims are 1-8 and 10-25, and the withdrawn method claims are 9, 26, and 27.

Applicants' traversal is on the grounds that 1) the instant claims do not present a serious burden for examination, and 2) that the parent application was not restricted. Applicants' arguments have been considered, but have not been found persuasive.

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Regarding argument 1) above, the Examiner directs Applicants' attention to Section 803.02 of the MPEP, the subsection that addresses Markush-type claims:

"This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration."

Therefore, the claims herein lack unity of invention under MPEP 803.02, since the compounds defined in the claims lack a significant structural element qualifying as the substantial structural feature that defines a contribution over the prior art. The compounds claimed contain only a phenyl-sulfanyl moiety in common (variables **excluded**), which does not define a contribution over the prior art. Furthermore, the substituents vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

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Regarding argument 2) above, the Examiner would like to remind Applicants that each case is examined on its own merits, regardless of the method in which another examiner may have prosecuted a previous case, *In re Geollette and Hoffman*, 188 USPQ.

The requirement is still deemed proper and is therefore made FINAL.

5. Accordingly, claims 9, 26 and 27, drawn to methods, are withdrawn from consideration pursuant to 37 CFR 1.142(b), as directed to non-elected subject matter.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8 and 10-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite definitions for “R<sup>5</sup>”, yet Applicants have not provided any indication of an “R<sup>5</sup>” variable in formula I. Clarification is requested.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 8, 10, 13, 16, and 21, (all in part) rejected under 35 U.S.C. 102(b) as being anticipated by Cox et al, U.S. 4,900,571. Cox et al teach pyridyl-phenyl-sulfanyl-heteroaryl compounds that read on those instantly claimed, for example compounds of “Formula I” in column 1, wherein “p” is 0, “y” is 0, “A” is a phenyl ring, and “W” is a pyridyl ring, which are

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the same as those instantly claimed when R<sup>1</sup> is pyridine and A is a bicyclic heterocyclyl group.

Please refer to Cox et al species of Example 13(a), Example 14 (a)-(j)(i), Example 15 (a), Example 16(b), Example 18(b), Example 19(a), Example 21(a), etc., and the claims, which also recite numerous species that read on the instant claims.

### ***Claim Objections***

10. Claims 2-7, 11, 12, 14, 15, 17-20, and 22-25 objected to for being dependent on rejected base claims.

### ***Conclusion***

11. Claims 1-27 are pending in the application, claims 8, 26 and 27 are currently withdrawn from consideration, claims 1-8 and 10-25 stand rejected, and claims 2-7, 11, 12, 14, 15, 17-20, and 22-25 are also objected to.

### ***Telephone Inquiry***

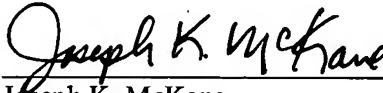
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins  
May 13, 2005

  
\_\_\_\_\_  
Joseph K. McKane  
SPE, Art Unit 1626